



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,230	12/04/2003	Masayuki Ushiku	03723/HG	9225
1933	7590	02/13/2006	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708			SCHWARTZ, PAMELA R	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/729,230	Applicant(s) USHIKU, MASAYUKI	
	Examiner Pamela R. Schwartz	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-3, 5, 6, 8 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 6 and 8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse by original presentation of Group I.

2. Claims 1-3, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katoh et al. (US 2002/0130943) for reasons of record, taken alone, or in view of Maekawa (6,991,330). It is well known in the art to pulverize and sort particles as a method of controlling particle size. Therefore, it would have been obvious to one of ordinary skill in the art to use particles that have been pulverized as the silica of the primary reference. The reference discloses particles that meet the relationship that is set forth by claim 1 and also discloses inclusion of a cationic compound as is now set forth.

To support the conventional nature of pulverizing and sorting particles, the examiner cites Maekawa. The reference discloses an ink jet recording material including silica that has undergone pulverization and classification (see col. 4, line 42 to col. 5, line 43). Based upon this disclosure and that of the primary reference, it would have been obvious to include conventional silica processed by a conventional process such as pulverizing, in order to obtain secondary particles of a desired size range.

3. Claims 1-3, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ashida et al. (6,773,771) for reasons of record, taken alone, or in view of Maekawa (6,991,330). It is well known in the art to pulverize and sort particles as a method of controlling particle size. Therefore, it would have been obvious to one of ordinary skill in the art to use particles that have been pulverized as the silica of the primary reference.

The reference discloses particles that meet the relationship that is set forth by claim 1 and also discloses inclusion of a cationic compound as is now set forth.

To support the conventional nature of pulverizing and sorting particles, the examiner cites Maekawa. The reference discloses an ink jet recording material including silica that has undergone pulverization and classification (see col. 4, line 42 to col. 5, line 43). Based upon this disclosure and that of the primary reference, it would have been obvious to include conventional silica processed by a conventional process such as pulverizing, in order to obtain secondary particles of a desired size range.

4. Applicant's arguments filed November 17, 2005 have been fully considered but they are not persuasive. Applicants' arguments are once again directed to their Declaration and newly filed Supplemental Declaration. The Supplemental Declaration does not remedy all of the deficiencies of the first Declaration. It does not state why Sheet Nos. 25, 28 and 35 were selected over other sheets which seem equally suitable but which were passed over for these selections. The Declaration needs to state exactly what was done to form the media. For example, the initial Declaration states that Example 1 of Katoh et al. was followed. The Supplemental Declaration states that a polyethylene coated support "as described in Example 1" of Katoh et al. was used. Did applicants make the resin coated support by the method set forth in Katoh et al., Example 1, or did they use a commercially available support? While this is a detail, it would indicate that Example 1 was substantially followed but not exactly followed. That level of detail should be present in the Declaration. The process steps followed by applicants need to be written out in the Declaration so that the examiner can determine

Art Unit: 1774

if there are any deviations between the prior art and the method used by applicants and so that the examiner can consider if the differences would or would not make a difference in results. This level of detail has not been provided. Another example: How did the composition of ink used in the experiments run by applicants compare with the ink compositions set forth at [0198] of the reference? The examiner cannot make this comparison, although it is relevant, because sufficient information has not been provided. Therefore, the Declarations are not persuasive. Additionally, they are not directed to Ashida et al.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

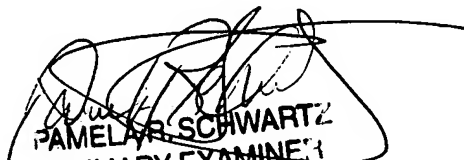
Art Unit: 1774

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pamela R. Schwartz
February 4, 2006



PAMELA R. SCHWARTZ
PRIMARY EXAMINER